

REMARKS

In an Office Action mailed on April 8, 2003, claims 3, 11, 20 and 22 were rejected under 35 U.S.C. § 112, second paragraph; claims 1, 3-5, 8,9, 11, 13, 18, 20-22 and 24-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen; claims 2, 7, 10, 12, 15-17, 19 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of alleged Applicant's Admitted Prior Art (AAPA); and claims 6 and 14 were objected to as being dependent upon rejected base claims but allowable if rewritten in independent form. Claims 3, 11, 20 and 22 have been amended to overcome the § 112 rejections. Newly added claims 27 and 28 are patentable over the cited art. The § 103 rejections are discussed below.

§ 103 Rejections of Claims 1-10:

The computer system of claim 1 includes a buffer to capture data directly from a memory bus. Claim 1 states that the buffer is located closer to the local bus than to the memory bus.

The Examiner rejects independent claim 1 under 35 U.S.C. § 103(a) as being unpatentable in view of Chen. However, as admitted by the Examiner, "Chen does not explicitly disclose that the buffer being located closer to the local bus than to the memory bus." Office Action, 2-3. Therefore, to derive a case of obviousness for independent claim 1, the Examiner concludes that it would have been obvious to modify Chen's I/O bridge so that a buffer (of this bridge) that captures data directly from a memory bus is closer to the local bus, "because this would provided for the buffer closely associated with the local bus and thereby allowed faster data transfer from the buffer to the local bus. *Id*, 3.

To establish a *prima facie* case of obviousness, there must be a suggestion or motivation in the prior art to modify a reference. The Examiner merely concludes a case of obviousness without showing where the prior art contains the alleged suggestion or motivation to modify Chen, as set forth by the Examiner's rejection. However, the Examiner must show, with specific citations to a prior art reference where the prior art contains the alleged suggestion or motivation to modify Chen. *See, Ex parte Gambogi*, 62 USPQ2d 1209, 1212 (Bd. Pat. App. & Int. 2001); *In*

re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); M.P.E.P. § 2143. As "obviousness cannot be predicated on what is unknown," a *prima facie* case of obviousness has not been established for independent claim 1. To the extent the Examiner is taking Official Notice of the alleged suggestion or motivation to modify Chen as set forth in the Office Action, Applicant hereby challenges this notice and requests a reference to support the Examiner's position. M.P.E.P. § 2144.03.

Claims 2-10 are patentable for at least the reason that these claims depend from an allowable claim.

§ 103 Rejections of Claims 11-17:

The bridge of claim 11 includes a local bus interface that is located closer to a local bus than to a memory bus.

The Examiner rejects independent claim 11 under 35 U.S.C. § 103(a) as being unpatentable in view of Chen. As admitted by the Examiner, Chen does not disclose a local bus interface that is located closer to a local bus than to a memory bus. Rather, the Examiner concludes a case of obviousness without showing where the prior art allegedly contains the alleged suggestion or motivation to modify Chen. However, this is improper, as the Examiner must show, with specific citations to the prior art, where the prior art contains the alleged suggestion or motivation. To the extent the Examiner is taking Official Notice for the alleged suggestion or motivation, Applicant hereby challenges the notice and requests the Examiner to produce a document that supplies the alleged suggestion or motivation. M.P.E.P. § 2144.03.

Claims 12-17 are patentable for at least the reason that these claims depend from an allowable claim.

Rejections of Claims 18-21:

The method of claim 18 includes capturing data directly from a memory bus in a buffer that is located closer to a local bus than to the memory bus.

The Examiner rejects independent claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Chen. However, as admitted by the Examiner, Chen does not supply the teaching of capturing data from a memory bus and a buffer that is located closer to a local bus than to a memory bus. As set forth above, the Examiner fails to establish a *prima facie* case of obviousness for independent claim 18 for at least the reason that the Examiner fails to show where the prior art contains the alleged suggestion or motivation to modify Chen so that data is captured directly from a memory bus in a buffer that is located closer to a local bus than to the memory bus. Thus, for at least this reason, a *prima facie* case of obviousness has not been established for independent claim 18, and withdrawal of the § 103 rejection of this claim is requested. To the extent the Examiner is taking Official Notice of the alleged suggestion or motivation, Applicant hereby challenges the notice and requests a reference to support the Examiner's position. M.P.E.P. § 2144.03.

Claims 19-21 are patentable for at least the reason that these claims depend from an allowable claim.

Rejections of Claims 22-26:

As amended, the method of claim 22 recites extending a memory bus into a bridge and recites that the memory bus is adapted to indicate data in a memory read operation. Furthermore, the method of claim 22 includes capturing the data directly from the extension of the memory bus into the bridge.

The Examiner rejects independent claim 22 under 35 U.S.C. § 103(a) in view of Chen. However, Chen neither teaches nor suggests extending a memory bus into a bridge. Furthermore, the Examiner fails to provide any support for the alleged suggestion or motivation to modify Chen to derive the missing claim limitations. Such support must be shown with specific citations to the prior art. To the extent the Examiner is taking Official Notice for the alleged suggestion or motivation, Applicant hereby challenges the notice and requests a

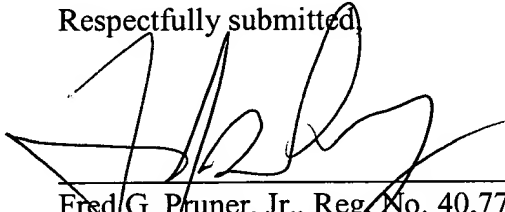
reference that shows the alleged suggestion or motivation. Otherwise, withdrawal of the § 103 rejection of independent claim 22 is requested.

Claims 23-26 are patentable for at least the reason that these claims depend from an allowable claim.

CONCLUSION

In view of the foregoing, withdrawal of the §§ 112 and 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (MCT.0078US).

Respectfully submitted,



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